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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,506	09/04/2003	Paul Anthony Halstead	33528/RFT/VEJ	8021

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EXAMINER

BRITTAIN, JAMES R

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/656,506

Applicant(s)

HALSTEAD, PAUL ANTHONY

Examiner

James R. Brittain

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-14, 16 and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4, 5, 10-14, 16 and 18 is/are rejected.
- 7) ☒ Claim(s) 6-9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Specification Objections

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP §608.01(o). Correction of the following is required: The term “an activator portion” (claim 4, line 9) is not used in the specification.

Claim Objections

Claim 9 is objected to because of the following informalities: The term “the actuator portion” (lines 2-3) lacks clear antecedent basis. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

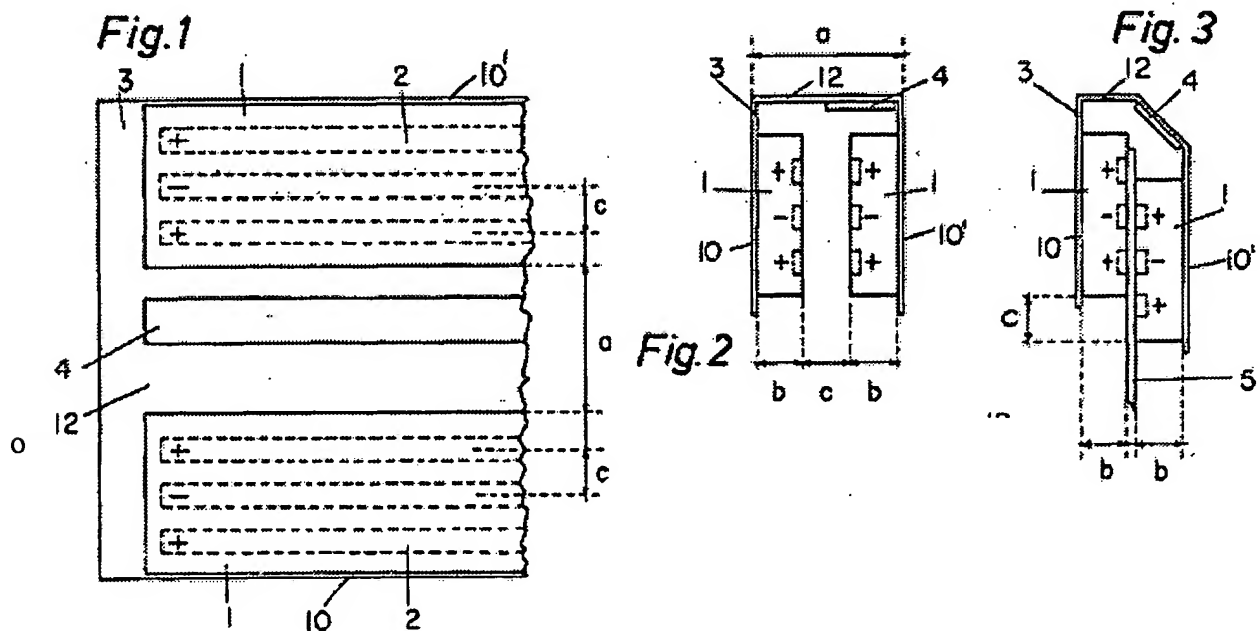
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 4, 5, 10-14 and 18 are rejected under 35 U.S.C. §102(b) as being clearly anticipated by Hutter (US 4222489).

Hutter (figures 1-3) teaches a clip for holding paper and therefore inherently capable of holding banknotes having a first clasp portion 10' and a second clasp portion 10 for holding banknotes therebetween, the first clasp portion having a first magnetic portion 1 including magnetic material and the second clasp portion having a second magnetic portion 1 including magnetic material, wherein the first magnetic portion is moveable relative to the second magnetic portion between: a closed position whereby the interaction of the magnetic material of

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the first and second magnetic portions is such that there is a net force of attraction to hold the first and second clasp portions together; and an open position whereby the first and second clasp portions are released apart. Figure 1 shows that there are spaced bands 2 of alternating polarity sequentially arranged across the width of the clamp and generate an open configuration when the facing polarities are alike (figure 2) and a closed configuration when the facing polarities are opposite (figure 3). The polarity of each band 2 inherently reverses through the thickness of the band. A flexible hinge connects the two clasp portions together and permits the requisite movement for the operation of the clasp (col. 4, lines 57 - col. 6, line 3 and col. 6, lines 10-15). The edges of the clasp portions are grippable and function as an activator portion for relative manual movement of the first magnetic portion as shown in the below figures.



Claim 16 is rejected under 35 U.S.C. §103(a) as being unpatentable over Hutter (US 4222489) in view of Mars (US 6282760).

Hutter (figures 1-3) teaches a clip for holding paper and therefore inherently capable of holding banknotes having: two clasp portions 10, 10' moveable relative to one another for holding the paper therebetween; and magnetic material 1 operably associated with the clasp portions, the magnetic material being moveable between a first closed position whereby the operation of the magnetic material is such as to hold the first and second clasp portions together and an open position whereby the first and second clasp portions are released apart. A flexible hinge connects the two clasp portions together and permits the requisite movement for the operation of the clasp (col. 4, lines 57 - col. 6, line 3 and col. 6, lines 10-15). The difference is that the magnetic material is not stated as being rare earth magnets. However, such magnets are common and well known for their good qualities as taught by Mars (figure 8; col. 4, lines 9-19) which suggests Neodymium-Iron-Boron magnets as having strong magnetic properties so as to clamp material between two such magnets. As it would be beneficial for the clasp of Hutter to possess good clamping characteristics it would have been obvious to utilize rare earth magnets as suggested by Mars because of Mars recognizing their strong magnetic properties that would be useful in the clamping arts.

Allowable Subject Matter

Claims 6-9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims along with correcting the objections identified above.

Response to Arguments

Applicant's arguments have been fully considered but they are not persuasive.

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Applicant argues that the nominal recitation of an “activator portion” in claim 4 is sufficient to distinguish over Hutter. The argument is unpersuasive because the clasp of Hutter must be gripped and the gripping and sliding of the first clasp portion relative to the second clasp portion provide contact for an operator’s fingers that provide the shifting movement and hence function as actuator portions. Applicant’s construction requires no relative movement of the first magnetic portion with respect to the first clasp portion. In fact claim 7, a dependent claim, recites the relative movement of the two, thereby indicating applicant realizes that claim 4 requires no relative movement of the first magnetic portion relative to the first clasp portion. In regard to claim 10, applicant even argues that the polarity of the magnetic material of Hutter may not reverse at all (page 7, ¶3, lines 6-7) and argues that the clear showing of the polarity changes in the bands is somehow not shown at all. The argument has no merit and obviously magnets have two poles and the teaching of Hutter is read by one of ordinary skill in the art and it is clear that the different polarized boundary regions arranged next to each other implies that inherently the polarity changes through the thickness. Applicant is reminded that “[I]n considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom.” *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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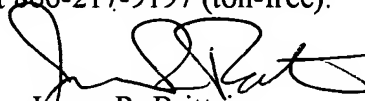
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James R. Brittain whose telephone number is 703-308-2222. The examiner can normally be reached on M, W & F 5:30-1:30, T 5:30-2:00 & TH 5:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on 703-306-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



James R. Brittain
Primary Examiner
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JRB